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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/631,414	08/03/2000	KENICHI MORITA	15162/02390	9594
24367	7590	01/13/2005	EXAMINER	
SIDLEY AUSTIN BROWN & WOOD LLP			KANG, PAUL H	
717 NORTH HARWOOD			ART UNIT	
SUITE 3400			PAPER NUMBER	
DALLAS, TX 75201			2141	

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/631,414

Applicant(s)

MORITA ET AL. 

Examiner

Paul H Kang

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6-8,10,11,13-16 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6-8,10,11,13-16 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Examiner Sajid Yussuf is no longer assigned to the present patent application. This application is now assigned to Examiner Paul H. Kang. In examining this patent application, full faith and credit has been given to the search and action of the previous examiner. MPEP § 719.05.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. *Claim(s) 1-2, 4, 6-8, 10-11, 13-16 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Maeda, US Pat. App. No. 2003/0107776 A1.*

5. As per claims 1, 6, 7, 14 and 16, Maeda teaches a data communication apparatus capable of connecting a plurality of communication lines, comprising:

a specification unit for specifying a transmission destination (Abstract and ¶¶ 0006-0010);

a transmission unit for transmitting a plurality of its own address data corresponding to each of the plurality of communication lines to the specified transmission destination (¶¶ 0006-0010 and 0015-0021);

a receiving unit for receiving a plurality of address data from a data communication apparatus at the transmission destination (¶¶ 0006-0010 and 0015-0021); and

a recording unit for recording the address data received by the receiving unit (¶¶ 0006-0010 and 0015-0021).

6. As per claim 2, Maeda teaches the claimed invention as described in claim 1 above, further comprising a transmission unit to transmit the address data together with the image data (¶¶ 0006-0010 and 0015-0021).

7. As per claims 4 and 8, Maeda teaches the claimed invention further comprising a controller for controlling the use of received/recorded address data (¶¶ 0006-0010 and 0015-0021).

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8. As per claim 10, Maeda teaches the claimed invention as described above, further comprising a memory for storing the address data (¶¶ 0006-0010 and 0015-0021).

9. As per claim 11, Maeda teaches the claimed invention as described above, further comprising a system and method wherein the controller is adapted to search the recording unit for an address corresponding to the specified transmission destination (¶¶ 0020-0021).

10. As per claim 13, Maeda teaches the claimed invention as described above, further comprising a system and method wherein the recording unit is adapted to update previously recorded addresses with the received address data (¶¶ 0015-0021).

11. As per claim 15, Maeda teaches the claimed invention as described in claim(s) 1-14 above and furthermore discloses obtaining an address of the specified transmission destination by retrieving from a memory a plurality of addresses corresponding to the specified transmission destination and selecting one of the retrieved plurality of addresses (¶¶ 0015-0021).

12. As per claim 19, Maeda teaches a user interface adapted to accept from a user an identification of another data communication device; and a processor programmed to retrieve from the second memory a plurality of addresses for the user identified data communication device (¶¶ 0015-0021).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda in view of Suzuki et al. (US Patent No. 6,005,677 and Suzuki hereinafter).

15. As per claim 12, Maeda discloses the controller is adapted to retrieve an address from the recording unit when an address corresponding to the specified transmission destination is found (¶¶0015-0021).

However, Maeda does not explicitly teach prompting a user to provide an address when an address corresponding to the specified transmission destination is not found. In the same field of endeavor, Suzuki teaches prompting a user to provide an address when an address corresponding to the specified transmission destination is not found; wherein it is interpreted that the user provides the update for an address (See Suzuki, Column 4 Lines 56-67 & Column 5 Lines 1-13).

It would have been obvious to a person having ordinary skill in the art at the time of Applicant's invention to incorporate prompting a user as taught by Suzuki into the addressing system of Maeda for the purpose of enhancing user control by enabling user to designate whether the internet or PSTN is to be used.

Conclusion

Applicant's arguments with respect to claims 1-2, 4, 6-8, 10-11, 13-16 and 19 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H Kang whose telephone number is (571) 272-3882. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


PAUL H. KANG
PRIMARY PATENT EXAMINER